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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,899	12/21/2000	Werner Taubmann	40551/DBP	6061

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,899

Applicant(s)

TAUBMANN ET AL.

Examiner

Gregory J. Strimbu

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/20/04, 3/29/04 and 2/24/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16-21,23-25,27-43 and 48-56 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,25 and 34-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-14,16-21,23,24,27-33,43,48-51 and 53-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/24/04 + 3/29/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 13, 2003 have been approved.

Claim Rejections - 35 USC § 112

Claims 1, 4, 6-14, 16-21, 23, 24, 27-33, 43 and 48-56 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "a guide rail assembly" on line 3 of claim 1 render the claims indefinite because it is unclear if the guide rail assembly comprises part of the adjusting device or is separate from the adjusting device. Recitations such as "rotationally fixed on and relative to" on line 7 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. How is the spindle rotationally fixed? If the spindle is fixed, how can it rotate?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6-9, 12, 13, 16-21, 23, 24, 43, 53, 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Isomura '872. Isomura '872 discloses a drive for

Art Unit: 3634

adjusting devices in motor vehicles comprising: a guide rail assembly 46 having a first rail 50 and a second rail 54 that are displaceable relative to each other, the first rail and the second rail defining a hollow cavity there between (not numbered, but shown in figure 3); a threaded spindle 28 rotationally fixed on and relative to one the first and second rails; a gear assembly 16, 18 mounted on the other the first and second rails and operably connected to the threaded spindle; a gear housing 83 holding the gear assembly, with the gear housing having at least two housing plates 83 fixed against each other by plug-in connectors 106; each plug-in connector comprising a rigid plug (not numbered, but comprising the head of the bolt) at one of the at least two housing plates and a receptacle 90 for the plug at the other of the at least two housing plates, and each plug-in connector is connected by plugging the plug into a respective one of the receptacles; wherein the gear housing and the gear assembly are located in the hollow cavity as shown in figure 3, an additional pair of disc shaped housing plates 94.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isomura '872 as applied to claims 1, 4, 6-9, 12, 13, 16-21, 23, 24, 43, 53, 55 and 56 above, and further in view of Weber. Weber discloses a drive for adjusting devices

Art Unit: 3634

in motor vehicles comprising one of a fixed spindle and a fixed toothed rack 11 fixed on one of two relatively displaceable pads, a gear assembly 15, 30 mounted on the other of the two relatively displaceable parts, and a gear housing holding the gear assembly, with the gear housing having at least two housing plates 1 and 2 which can be fixed against each other by plug in connectors 8, 10 each plug in connector comprising a plug at one of the at least two housing plates and a receptacle for the plug at the other of the at least two housing plates, and the plug in connector is connected by plugging the plug into a respective one of the receptacles, wherein the plug in connectors are formed sufficiently rigid to fix the at least two housing plates relative to each other in all three dimensional directions and to form supporting connecting joints which absorb gear forces and wherein the at least two housing plates are fixed relative to each other solely at the plug-in connectors, the plug in connector includes two surfaces which converge (not numbered, but shown as the arrowhead portion of each plug in connector).

It would have been obvious to one of ordinary skill in the art to provide Isomura '872 with additional plug in connectors, as taught by Weber, to increase the ease with which the gear housing can be assembled.

Claims 14 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isomura '872 as applied to claims 1, 4, 6-9, 12, 13, 16-21, 23, 24, 43, 53, 55 and 56 above, and further in view of Weber. Weber discloses a drive for adjusting devices in motor vehicles comprising one of a fixed spindle and a fixed toothed rack 11 fixed on one of two relatively displaceable pads, a gear assembly 15, 30 mounted on the other of

Art Unit: 3634

the two relatively displaceable parts, and a gear housing holding the gear assembly, with the gear housing having at least two housing plates 1 and 2 which can be fixed against each other by plug in connectors 8, 10 each plug in connector comprising a plug at one of the at least two housing plates and a receptacle for the plug at the other of the at least two housing plates, and the plug in connector is connected by plugging the plug into a respective one of the receptacles, wherein the plug in connectors are formed sufficiently rigid to fix the at least two housing plates relative to each other in all three dimensional directions and to form supporting connecting joints which absorb gear forces and wherein the at least two housing plates are fixed relative to each other solely at the plug-in connectors, the gear assembly includes a spindle nut 30 having an internal thread 33 and with external worm wheel teeth 32 and a drive worm 15 engaging the worm wheel teeth, the internal thread threadedly engaging a threaded spindle 11.

It would have been obvious to one of ordinary skill in the art to provide Isomura '872 with gear assembly, as taught by Weber, to decrease the amount of space required for the gear assembly.

Claims 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isomura as applied to claims 1, 4, 6-9, 12, 13, 16-21, 23, 24, 43, 53, 55 and 56 above. Isomura is silent concerning the particular method by which the invention described therein is assembled. However, assembling the invention as set forth by Isomura would inherently lead to the method steps set forth in claims 27-33.

Allowable Subject Matter

Claim 52 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach a holder having a base and two spaced apart projecting portions extending from the base to form a U-shaped gear socket, the gear housing and the gear assembly are mounted between the projecting portions of the U-shaped gear socket with the spindle passing through the projecting portions and wherein the holder, the gear housing and the gear assembly are located in the hollow cavity. See claim 52, lines 20-21 and 32-36.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mouri et al. '242 and '520, Mouri '158 and '257, Ito et al. '555 and '013, Miyauchi, and Rees are cited for disclosing a gear assembly housing mounted in the space defined between two sliding rails.

Response to Arguments

Applicant's arguments filed March 29, 2004 have been fully considered but they are largely moot in view of the new grounds of rejection. However, the applicant's

Art Unit: 3634

comments concerning Weber are pertinent to the current rejection and have been addressed below.

In response to applicant's argument that Weber is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the applicant and Weber were concerned with the problem of driving one element of a vehicle relative to another element of the vehicle with the use of a threaded shaft.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The applicant has amended the claims and presented new claims which include the additional limitation of the gear housing and the gear assembly are located in the hollow cavity. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

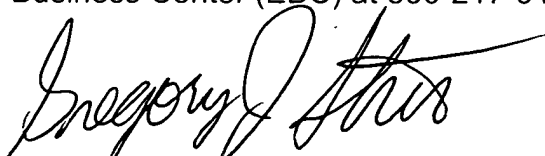
Art Unit: 3634

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Strimbu
Primary Examiner
Art Unit 3634
February 18, 2005